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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.  | CONFIRMATION NO. |
|---|-------------|----------------------|----------------------|------------------|
| 10/027,440  | 12/20/2001  | Sandip H. Mander     | 884.623US1           | 1921             |
| 21186   | 7590        | 06/06/2006           | EXAMINER             |                  |
| SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.<br>P.O. BOX 2938<br>MINNEAPOLIS, MN 55402 |             |                      | RUHL, DENNIS WILLIAM |                  |
|   |             |                      | ART UNIT             | PAPER NUMBER     |
|   |             |                      | 3629                 |                  |

DATE MAILED: 06/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 10/027,440             | MANDERA, SANDIP H.  |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | Dennis Ruhl            | 3629                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 22 March 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 22-25 and 32-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 22-25, 32-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

Art Unit: 3629

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/22/06 has been entered.

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 22-25,32-40, are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Applicant has claimed an apparatus or a system that has a server and a second electronic device, where the 2<sup>nd</sup> electronic device is to receive a service request from a first electronic device, to fulfill a portion of the service request, and to find a 3<sup>rd</sup> electronic device to send a remaining portion of the service request to. In the instant specification applicant has disclosed that the "services" may comprise both goods and services, very broad language left open to anything. The examiner does not feel that the specification provides an enabling disclosure of how the electronic device actually

Art Unit: 3629

fulfills the service request and finds another electronic device that can fulfill a remaining portion of the service request. Because the scope of the claims allow for the service request to be a request such as a request to have a clothes washer fixed, or to be a request to have a furnace fixed, how does the electronic device(s) fulfill the service request? One of skill in the art would not know how to go about making an electronic device that can fulfill a service request such as fixing a furnace in the home of a customer or fixing a clothes washer. How does the electronic device go to the home of the customer and fix the furnace? This is more or less what the claims are reciting. There is insufficient teaching as to how the electronic device is made so that it can actually fulfill any kind of service request. The examiner also does not see any kind of sufficient disclosure that would enable one of skill in the art to make an electronic device so that it can find another electronic device to fulfill the remaining portion of the service request. How is this done? If the service request is to have the oil changed in a car and the air conditioning serviced, how does the 2<sup>nd</sup> electronic device change the oil? One of skill in the art would have no idea how to make the 2<sup>nd</sup> electronic device perform such as activity. How does the electronic device know that a given automotive service provider can change the oil but cannot do the AC service, and from there, how does the 2<sup>nd</sup> electronic device then find another electronic device that can perform the AC servicing? How then does the 3<sup>rd</sup> electronic device perform the AC servicing? This is not taught in the instant specification. The examiner does not feel that one of skill in the art after reading the disclosure would be able to make the apparatus or system as

Art Unit: 3629

claimed so that it can perform the recited intended use. The claims are not enabled by the specification.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 22-25,32-35,40, are rejected under 35 U.S.C. 102(b) as being anticipated by Rondeau (5850433).

For claims 22,32, Rondeau discloses an online service directory where a customer can search for a desired service. There is a registry server (28 and 14) that contains descriptive information about services that are available and that satisfies what is claimed. The 2<sup>nd</sup> electronic device is 18. The network/network adapter is 32. With respect to the language reciting that the 2<sup>nd</sup> electronic device is “to fulfill a portion of the service request received.....and to send a remaining portion of the service request to a 3<sup>rd</sup> electronic device...” a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963). In this

Art Unit: 3629

case, the claimed intended use imparts no further structure to the claim and is solely directed to the intended manner of use. Applicant should take notice that all the claim recites structurally is a server, a registry, and an electronic device (singular). This is anticipated by Rondeau. Concerning the ability of the electronic device of Rondeau to perform the claimed intended use, the examiner notes that the claims do not require that there is no human interaction involved in the fulfilling of the service request and in the finding of a 3<sup>rd</sup> electronic device. The electronic device of Rondeau is fully capable of being used by a human being to fulfill a portion of a service request (can be the ordering of goods from an online merchant) and to find another provider that can perform a given service. The electronic device of Rondeau can be used in a manner claimed due to the fact that a human being can be the one actually instructing the electronic device on what to do.

For claims 23-25,33-35,40, these claims are reciting the intended use of the apparatus and are also anticipated by Rondeau for the same reasons as explained with respect to claims 22,32. There is no 3<sup>rd</sup> electronic device in the scope of the claims because the 3<sup>rd</sup> electronic device is only claimed in a function sense (it is just part of the intended use of the 2<sup>nd</sup> electronic device). Applicant has not positively claimed that there is in fact another electronic device in the apparatus or system that is being claimed.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 3629

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 36-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rondeau (5850433).

For claims 36,37, Rondeau does not disclose that the registry server is implemented in XML. XML is a well-known language that was developed to make sharing of information on the Internet easy. This kind of language is old and well known to one of ordinary skill in the art, and the examiner takes official notice of this fact. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have Rondeau use Extensible Markup Language so that the sharing of information can be easy as the creators of XML envisioned.

For claims 37 (even though it has been addressed immediately above) and 39, the examiner wants to point out that the actual service request itself is not part of the scope of the claims and is not a positively claimed element, so reciting what format it has is not really reciting any further structure to the system or is not reciting any further structure to one of the recited elements of the system. The same applies to claim 39. The service request is not positively claimed as a claimed element and is not even a real work structural thing. The service request is just what the claimed apparatus or system is used with but is not part of the apparatus or the system. Rondeau satisfies what is claimed.

For claim 38, Rondeau does not disclose that the registry server is implemented in EDI. EDI is a well-known computer language that is old and well known to one of

Art Unit: 3629

ordinary skill in the art, and the examiner takes official notice of this fact. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have Rondeau use Electronic Data Interchange (EDI) language because one of ordinary skill in the art would recognize that language as one of the choices available and because it is known to work. EDI, just like XML, is old and well known in the art and is obvious to one of ordinary skill in the art.

8. Applicant's arguments filed 3/22/06 have been fully considered but they are not persuasive. Applicant has argued that the examiner has not set forth a basis in fact or technical reasoning as to why the intended use recitations are inherently found in Rondeau. The examiner refers applicant to the rejection of this office action where the rationale is set forth for the inherency. Applicant has argued that Rondeau has no registry server. Why not? Rondeau has a processor and a database that stores information about service providers and the services they perform, just like the instant invention. Rondeau has a server registry as claimed and the argument is non-persuasive. With respect to the argument about how the invention of Rondeau works, applicant is reminded that the presently pending claims are apparatus claims and not method claims. As stated in the rejection, the claimed limitations about what the 2<sup>nd</sup> electronic device is supposed to do is intended use language. Additionally, where in the claims is it recited that the **server** responds to only a portion of a service request, as has been argued? This argument is not commensurate with the scope of the claims. Applicant has argued that the network adapter in Rondeau is a LAN and this does not



Art Unit: 3629

satisfy what claim 32 recites. Claim 32 generically recites a network adapter and the specification on page 4 specifically includes a LAN in the scope of what is claimed. Applicant has disclosed a LAN so unless the claim specifically excludes a LAN, the rejection is proper. What applicant contemplated the language of claim 32 to mean is not as important as what claim 32 recites. What the claim recites is what is examined, not what is contemplated. The arguments are non-persuasive.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Ruhl whose telephone number is 571-272-6808. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



DENNIS RUHL  
PRIMARY EXAMINER